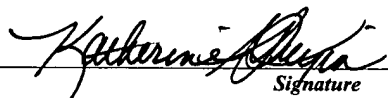
**TRANSMITTAL OF APPEAL BRIEF (Large Entity)**Docket No.
14196 *AFB*In Re Application Of: **Taira Hanaoka, et al.**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/748,843	December 27, 2000	Jeffrey D. Carlson	23389	3622	6311

Invention: **PORTABLE INFORMATION TERMINAL APPARATUS AND INFORMATION
PROVISION METHOD**COMMISSIONER FOR PATENTS:Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:
February 27, 2006The fee for filing this Appeal Brief is: **\$500.00**

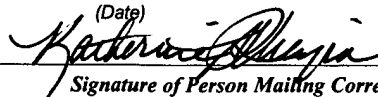
- ☒ A check in the amount of the fee is enclosed.
- ☐ The Director has already been authorized to charge fees in this application to a Deposit Account.
- ☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 19-1013/SSMP. I have enclosed a duplicate copy of this sheet.
- ☐ Payment by credit card. Form PTO-2038 is attached.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.
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April 27, 2006

(Date)


Signature of Person Mailing Correspondence**Katherine R. Vieyra**

Typed or Printed Name of Person Mailing Correspondence

KRV/ej
cc:



APPEAL BRIEF

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Taira Hanaoka et al.

Examiner: Jeffrey D. Carlson

Serial No: 09/748,843

Art Unit: 3622

Filed: December 27, 2000

Docket: 14196

For: PORTABLE INFORMATION
TERMINAL APPARATUS AND
INFORMATION PROVISION METHOD

Dated: April 27, 2006

Confirmation No.: 6311

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

I. INTRODUCTION

Pursuant to 35 U.S.C. § 134 and 37 C.F.R. § 41.37, entry of this Appeal Brief in support of the Notice of Appeal filed February 22, 2006 in the above-identified matter is respectfully requested. This paper is submitted as a brief setting forth the authorities and arguments upon which Appellants rely in support of the appeal from the Final Rejection of Claims 1, and 3-14 in the above-identified patent application on August 23, 2005.

II. STATEMENT OF REAL PARTY OF INTEREST

The real party of interest in the above-identified patent application is NEC Corporation.

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500.00 OP

III. STATEMENT OF RELATED PROCEEDINGS

There are no pending appeals or interferences related to this application to Appellants' knowledge.

IV. STATEMENT OF SUPPORTING EVIDENCE

One page from *The Free On-line Dictionary of Computing*, obtained April 24, 2006, is attached as Exhibit A.

V. STATEMENT OF CLAIM STATUS AND APPEALED CLAIMS

A. Claim Status

Claim 1 stands rejected based on 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,546,418, Schena et al. (hereinafter "Schena") in view of U.S. Patent No. 6,587,859, Dougherty et al., (hereinafter "Dougherty").

Claim 2 is cancelled.

Claim 3 stands rejected based on 35 U.S.C. § 103(a) as being unpatentable over Schena, in view of Dougherty.

Claim 4 stands rejected based on 35 U.S.C. § 103(a) as being unpatentable over Schena, in view of Dougherty.

Claim 5 stands rejected based on 35 U.S.C. § 103(a) as being unpatentable over Schena in view of Dougherty.

Claim 6 stands rejected based on 35 U.S.C. § 103(a) as being unpatentable over Schena in view of Dougherty in view of U.S. Patent No. 5,848,396, Gerace.

Claim 7 stands rejected based on 35 U.S.C. § 103(a) as being unpatentable over Schena in view of Dougherty.

Claim 8 stands rejected based on 35 U.S.C. § 103(a) as being unpatentable over

Schena in view of Dougherty.

Claim 9 stands rejected based on 35 U.S.C. § 103(a) as being unpatentable over Schena in view of Dougherty.

Claim 10 stands rejected based on 35 U.S.C. § 103(a) as being unpatentable over Schena in view of Dougherty.

Claim 11 stands rejected based on 35 U.S.C. § 103(a) as being unpatentable over Schena in view of Dougherty.

Claim 12 stands rejected based on 35 U.S.C. § 103(a) as being unpatentable over Schena in view of Dougherty.

Claim 13 stands rejected based on 35 U.S.C. § 103(a) as being unpatentable over Schena in view of Dougherty.

Claim 14 stands rejected based on 35 U.S.C. § 103(a) as being unpatentable over Schena in view of Dougherty.

B. Appealed Claims

Claims 1 and 3-14 are appealed; a clean copy of these claims is attached hereto in Appendix A.

VI. STATEMENT OF AMENDMENT STATUS

The claims were not amended in the Response to the Final Rejection filed December 23, 2005.

VII. STATEMENT/EXPLANATION OF INVENTION

The present application, U.S. patent application Serial No. 09/748,843 filed on December 27, 2000, originally included Claims 1-14.

In an Official Action dated October 8, 2003, the Examiner rejected Claims 6-14 under 35 U.S.C. § 112, second paragraph, rejected Claims 6, 7, and 12 under 35 U.S.C. §102(e) as being anticipated by Schena, and rejected Claims 1-5 under 35 U.S.C. §103(a) as being unpatentable over Schena in view of Perkowski, U. S. Patent No. 6,625,581.

In a Response under 37 C.F.R. § 1.111 filed January 8, 2004, Appellants disagreed with the Examiner's rejections. Appellants cancelled claim 2 and incorporated the limitations therein into independent claims 1 and 6 to more clearly define the invention. Claims 3, 4, and 8-14 were also amended for consistency with amended claims 1 and 6. In response to the 35 U.S.C. § 112 rejection, the amendments to claims 6 and 8-14 were cited. In response to the 35 U.S.C. § 102(e) and § 103(a) rejections, the Appellants submitted arguments distinguishing the claimed invention from the cited prior art.

In the Final Official Action issued April 13, 2004, the Examiner rejected Claims 6, 7, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Schena in view of Dougherty, rejected Claims 8-11, 13, and 14 over Schena, and reiterated the rejection of Claims 1 and 3-5 under 35 U.S.C. §103(a) as being unpatentable over Schena in view of Perkowski. The 35 U.S.C. § 112 rejections were withdrawn. The Examiner did not find Appellants' arguments persuasive with respect to the 35 U.S.C. § 103(a) rejections. Appellants traversed the Examiner's rejections in a Response under 37 C.F.R. § 1.116 filed on July 7, 2004. Subsequently, an Advisory Action issued on August 24, 2004. Appellants amended independent claims 1 and 6 in an Amendment under 37 C.F.R. § 1.114 filed on September 13, 2004 along with a Request for Continued Examination.

In a Non-Final Official Action issued on December 1, 2004, the Examiner rejected claims 1 and 3-14 under 35 U.S.C. § 103(a) as being unpatentable over Schena in view of Dougherty and Official Notice taken.

In a Response under 37 C.F.R. § 1.111 filed June 1, 2005, Appellants amended Claims 1 and 6 to restore these claims to their state prior to amendment on September 13, 2004. Appellants traversed the rejection and argued that the combined references do not disclose or suggest an image used later as a bookmark at an information terminal as *inter alia*, required by independent Claims 1 and 6. Additionally, Appellants argued that there was no motivation to combine the references; in fact, Dougherty teaches away from Appellants' invention.

In the Final Official Action issued August 23, 2005, the Examiner reiterated the rejections of Claims 1 and 3-14 from the previous Official Action.

Appellants traversed the Examiner's rejections without amendment to the claims in a Response under 37 C.F.R. § 1.116 filed on December 23, 2005; a Notice of Appeal was filed on February 23, 2006. An Advisory Action issued on February 24, 2006.

Consequently, Claims 1 and 3-14 are the claims on appeal. A copy of the rejected claims is attached hereto in Appendix A.

The invention with respect to Claim 1 comprises a portable information terminal apparatus (1) comprising a display element (3), a communication element (41), a reading element (42, page 4, lines 20-22) which reads access destination information indicated on a printed matter (page 4, lines 12-15), said reading element including a scanner (42) which reads an image on said printed matter (page 14, lines 5-6) and an extraction element (page 4, lines 20-22, page 14, lines 15-17) which extracts said access destination information included in said image; a memory (34) which stores said image (page 14, lines 11-13); a control element (31,

Figure 3) which connects to an access destination (page 15, lines 11-12) corresponding to said access destination information through said communication element, receives contents from said access destination, and executes a browser (page 14, line 26) for displaying said received contents on said display element (3), wherein said image stored in said memory (34) is displayed on said display element (3) as a bookmark image associated with said access destination information (page 4, lines 22-24).

The invention with respect to Claim 3 comprises the portable information terminal apparatus according to claim 1, wherein said access destination information is a URL noted on said printed matter (page 13, line 27 to page 14, line 1).

The invention with respect to Claim 4 comprises the portable information terminal apparatus according to Claim 1, wherein said printed matter is a printed publication having a URL of contents containing a moving image associated with an article (page 21, lines 15-23) constituted by characters (page 21, lines 21-22) or a still image (page 21, lines 26-27) printed within or in the vicinity of said article.

The invention with respect to Claim 5 comprises the portable information terminal apparatus according to claim 4, wherein said contents include advertisement information (page 23, lines 1-2).

The invention with respect to Claim 6 comprises a method of information provision, the method comprising storing contents in a server accessible through a communication network, said contents being associated with an article on a printed publication (page 13, line 27 to page 14, line 1), said printed publication including a contents locating information indicating a location of said contents, said contents locating information being printed within or in the vicinity of said article (eg. URL to one skilled in the art); reading an

image on said printed publication (page 14, line 8) and storing said image in a memory (page 14, lines 11-13) by a portable information terminal apparatus (1); extracting said contents locating information from said image by said portable information terminal apparatus (page 14, lines 16-17); acquiring and displaying said contents by accessing said server through said communication network based on said contents locating information extracted by said portable information terminal apparatus (page 13, line 26 to page 14, line 17); and displaying said image stored in said memory as a bookmark image associated with said contents locating information by said portable information terminal apparatus (page 16, lines 13-15).

The invention with respect to Claim 7 comprises the information provision method according to claim 6, wherein said contents include advertisement information (page 23, lines 1-2).

The invention with respect to Claim 8 comprises the information provision method according to claim 6, wherein an accounting server (102) includes a charge table for registering an article having advertisement information added thereto (page 28, lines 18-19) and an advertisement charge previously set based on a content of said article in association with each other (page 28, lines 19-21), and an accounting file (109) for holding accounting information for each advertiser (page 27, lines 19-21, Figure 11), used so that an advertisement charge to be collected by an issuer of a printed publication from an advertiser (page 23, lines 22-25) is differentiated and imposed in accordance with an article to which said advertisement information is added.

The invention with respect to Claim 9 comprises the information provision method according to claim 6, wherein an accounting server (102) includes a charge table for registering an access number (access number charge table 531) and advertisement charge

information corresponding to said access number in association with each other and an accounting file (109) for holding accounting information for each advertiser used so that an advertisement charge to be collected by an issuer of a printed publication from an advertiser (page 23, lines 22-26) is differentiated and imposed in accordance with said access number of said advertisement information.

The invention with respect to Claim 10 comprises the information provision method according to claim 6, wherein an accounting server (102) includes a charge table for registering an advertisement time zone (advertisement time zone charge table 521) and advertisement charge information according to said advertisement time zone in association with each other (page 28, line 27 to page 29, line 2), and an accounting file (109) for holding accounting information for each advertiser used so that an advertisement charge to be collected by an issuer of a printed publication (page 23, line 22 to page 24, line 2) is differentiated and imposed in accordance with said advertisement time zone for providing said advertisement information.

The invention with respect to Claim 11 comprises the information provision method according to claim 6, wherein an accounting server (102) includes a charge table for registering a conformation for providing advertisement information (advertisement contents storage portion 104) and advertisement charge information according to said conformation in association with each other (page 26, line 24 to page 27, line 6), and an accounting file (109) for holding accounting information for each advertiser used so that an advertisement charge to be collected by an issuer of a printed publication (page 23, line 22 to page 24, line 2) is differentiated and imposed in accordance with said conformation for providing said advertisement information.

The invention with respect to Claim 12 comprises the information provision method according to claim 6, wherein a current position of said portable information terminal apparatus (1) having access is detected (page 30, line 27 to page 31, line 2) and advertisement information corresponding to said detected current position is selected to be included in said contents (page 31, lines 5-7).

The invention with respect to Claim 13 comprises the information provision method according to claim 6, wherein at least part of a communication charge generated in said portable information terminal apparatus (1) is imposed on an issuer of said printed publication (page 35, lines 11-13).

The invention with respect to Claim 14 comprises the information provision method according to claim 6, wherein at least part of a connection charge to a provider generated in said portable information terminal apparatus (1) is imposed on an issuer of said printed publication (page 35, lines 11-13).

VIII. STATEMENT/LIST OF EACH GROUND FOR REVIEW/ARGUMENT

1. STATEMENT OF THE REJECTION

Claims 1 and 3-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schena et al., (hereinafter “Schena”), in view of Dougherty et al. (hereinafter “Dougherty”).

2. ARGUMENT

(A) Examiner’s Rejection Of Independent Claims 1 and 6 Is Not Proper.

(I) References Only Teach That Links Can Be Stored or Encoded

Appellants submit that Schena et al. does not teach an image stored in memory and displayed on a display element as a bookmark. A bookmark is defined as a reference to a

document in the form of a URL and a title or comment string; applicant submits herewith a definition in *Free On-Line Dictionary of Computing*, April 26, 2006 (see Supporting Evidence). Thus a bookmark is complex and comprises two parts, the first being a link such as a URL and the second being a descriptor such as a title or other descriptive text.

Schena teaches providing a technology on a portal server (column 2, line 38) by collecting the necessary information from a scanner device (column 2, line 32). Schena discloses scanning a machine-readable code containing a link information corresponding to provider information and storing this code in a memory and then extracting the link information from the code in the memory. Also, user input information corresponding to the provider information is obtained and stored in the memory and this user input information along with the link information are then sent to the portal server via the network. The link information of Schena is disclosed to be monolithic information such as, for example, a universal resource locator, an Internet address information, trademark information, a source of origin, an organization name, a product name, a service name, benefit redemption information, provider defined information, user personal profile information, user interest information, server command information, and customer premises equipment preference information (Schena, column 3, lines 1-7). None of the above disclosed information is complex or multi-part link information such as a bookmark.

Dougherty is directed to improve the human/computer interface by providing printable interfaces that enable a user to invoke and control computer processes (Dougherty, column 2, lines 53-55). In order to achieve this object, Dougherty adopts Multicon Linkmark icons, as shown, for example, in Figure 10, which illustrates a Multicon Linkmark which contains a plurality of icons, such as an audio icon, a text icon, a video icon (Dougherty, column 10, line 63 to column 11, line 58). However, no teaching or suggestion is provided regarding how these

icons could be used or combined to create a bookmark. A user would need additional knowledge, and extra steps, to create a bookmark from the complex Multicon Linkmark of Dougherty. “Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment.” *Al-Site Corp. v. VSI International Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). Therefore, these two references teach only that link information or machine code can be scanned and stored and fail to teach or suggest a scanned image as a **bookmark** as recited in the independent claims.

(II) References Do Not Teach Creating or Using Bookmarks

Merely collecting links, codes or icons does not create a bookmark; other steps are required. In order to use the scanned links of Schena as a bookmark, knowledge of additional steps, known in the art, would be required by a user of these links. The user would have to at least create bookmarks from the links by providing images, titles and/or descriptive text for each of the links, identify the links to bookmarking software, and store these links as bookmarks along with corresponding icons or text. Schena does not suggest converting the links to create bookmarks.

Similarly, Dougherty does not teach or suggest creating bookmarks. Instead, Dougherty teaches encoded regions including multiple icons which symbolize various features of a plurality of regions. The Examiner states that it “would have been obvious to one of ordinary skill at the time of the invention to have included the image content within the machine-scannable code so that the links are more user-friendly and users can determine what content is available at the destination” (Office Action mailed August 23, 2005, p. 3, lines 3-6). However, even assuming, *inter alia*, this were true, the result of combining image content with the machine-scannable code would not create a bookmark. As stated above, additional steps are required and there is no

suggestion or motivation in Dougherty to perform these steps. Therefore, these two references teach only storing or encoding codes or links and fail to teach a **bookmark** as recited in the independent claims of the present invention.

Withdrawal of the rejection to the independent Claims 1 and 6 is, therefore, respectfully requested.

(B) Rejections of Dependent Claims are also Improper

(I) Claims 3-5 and 7-14 are Patentable Based Upon Dependency From Independent Claims 1 and 6, Respectively

Appellants respectfully submit that Claims 3-5 and 7-14 are patentable over the cited prior art based upon at least the above-identified analysis. Specifically, the hypothetically combined references fail to teach, suggest, or render obvious each and every limitation of independent Claims 1 and 6, from which Claims 3-5 and 7-14 depend, respectively.

Withdrawal of the rejection to the dependent Claims 3-14 is, therefore, respectfully requested.

IX. CONCLUSION

Based on the above arguments and remarks, Appellants respectfully submit that the claims of the instant invention on appeal are not anticipated or obvious in light of Schena and Dougherty, either individually or in combination. Consequently, the rejections of the claims based on such references are in error. In view of the remarks submitted hereinabove, the references applied against Claims 1 and 3-14 on appeal do not render those claims unpatentable under 35 U.S.C. § 103(a). Thus, Appellants submit that the §103 rejections are in error and must be reversed.

The Commissioner is hereby authorized to charge any additional fees or credit
any overpayment in connection herewith to Deposit Account No. 19-1013/SSMP.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Katherine R. Vieyra", written in a cursive style.

Katherine R. Vieyra
Registration No. 47,155

SCULLY SCOTT MURPHY & PRESSER, P.C.
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KRV/ej
Enclosure: Exhibit "A"

APPENDIX A

1. (Rejected) A portable information terminal apparatus comprising:

a display element;

a communication element;

a reading element which reads access destination information indicated on a printed matter, said reading element including a scanner which reads an image on said printed matter and an extraction element which extracts said access destination information included in said image;

a memory which stores said image;

a control element which connects to an access destination corresponding to said access destination information through said communication element, receives contents from said access destination, and executes a browser for displaying said received contents on said display element,

wherein said image stored in said memory is displayed on said display element as a bookmark image associated with said access destination information.

2. (Cancelled)

3. (Rejected) A portable information terminal apparatus as claimed in claim 1, wherein said access destination information is a URL noted on said printed matter.

4. (Rejected) A portable information terminal apparatus as claimed in claim 1, wherein said printed matter is a printed publication having a URL of contents containing a

moving image associated with an article constituted by characters or a still image printed within or in the vicinity of said article.

5. (Rejected) A portable information terminal apparatus as claimed in claim 4, wherein said contents include advertisement information.

6. (Rejected) An information provision method comprising:

- storing contents in a server accessible through a communication network, said contents being associated with an article on a printed publication, said printed publication including a contents locating information indicating a location of said contents, said contents locating information being printed within or in the vicinity of said article;
- reading an image on said printed publication and storing said image in a memory by a portable information terminal apparatus;
- extracting said contents locating information from said image by said portable information terminal apparatus;
- acquiring and displaying said contents by accessing said server through said communication network based on said contents locating information extracted by said portable information terminal apparatus; and
- displaying said image stored in said memory as a bookmark image associated with said contents locating information by said portable information terminal apparatus.

7. (Rejected) An information provision method as claimed in claim 6, wherein said contents include advertisement information.

8. (Rejected) The information provision method as claimed in claim 6, wherein an accounting server includes a charge table for registering an article having advertisement information added thereto and an advertisement charge previously set based on a content of said article in association with each other, and an accounting file for holding accounting information for each advertiser, used so that an advertisement charge to be collected by an issuer of a printed publication from an advertiser is differentiated and imposed in accordance with an article to which said advertisement information is added.

9. (Rejected) The information provision method as claimed in claim 6, wherein an accounting server includes a charge table for registering an access number and advertisement charge information corresponding to said access number in association with each other and an accounting file for holding accounting information for each advertiser used so that an advertisement charge to be collected by an issuer of a printed publication from an advertiser is differentiated and imposed in accordance with said access number of said advertisement information.

10. (Rejected) The information provision method as claimed in claim 6, wherein an accounting server includes a charge table for registering an advertisement time zone and advertisement charge information according to said advertisement time zone in association with each other, and an accounting file for holding accounting information for each advertiser used so that an advertisement charge to be collected by an issuer of a printed publication is differentiated and imposed in accordance with said advertisement time zone for providing said advertisement information.

11. (Rejected) The information provision method as claimed in claim 6, wherein an accounting server includes a charge table for registering a conformation for providing advertisement information and advertisement charge information according to said conformation in association with each other, and an accounting file for holding accounting information for each advertiser, used so that an advertisement charge to be collected by an issuer of a printed publication from an advertiser is differentiated and imposed in accordance with said conformation for providing said advertisement information.

12. (Rejected) The information provision method as claimed in claim 6, wherein a current position of said portable information terminal apparatus having access is detected and advertisement information corresponding to said detected current position is selected to be included in said contents.

13. (Rejected) The information provision method as claimed in claim 6, wherein at least part of a communication charge generated in said portable information terminal apparatus is imposed on an issuer of said printed publication.

14. (Rejected) The information provision method as claimed in claim 6, wherein at least part of a connection charge to a provider generated in said portable information terminal apparatus is imposed on an issuer of a said printed publication.

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bookmark

<World-Wide Web> A user's reference to a document on the World-Wide Web or other hypermedia system, usually in the form of a URL and a title or comment string.

Most World-Wide Web and Gopher browsers can save and load a file of bookmarks to allow you to quickly locate documents to which you want to refer again.

(1997-06-09)

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